

REMARKS

Applicants appreciate the consideration shown by the Office as evidenced by the Final Office Action mailed on August 18, 2003. In that Office Action, the Examiner rejected claims 1-35 and 38-45. In this Response, Applicants have cancelled claims 8-10, 26-28, and 36-37; and amended claims 1, 11-16, 19, 29-35, and 39. Applicants respectfully request reconsideration of the application by the Examiner in light of the above amendments and the following remarks offered in response to the Office Action.

1. Claim Rejections – 35 U.S.C. § 103(a): Sakashita in view of Willson

Claims 1-35 and 38-45 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sakashita (US 5,646,233) in view of Willson (US 6,063,633). Sakashita describes polycarbonate compositions and methods for preparing the same, while Willson describes a method and apparatus for catalyst testing. The Examiner asserts that testing the catalysts mentioned by Sakashita using the method of Willson would be an obvious combination, and thereby rejects the claims at issue. Applicants respectfully traverse this rejection.

The method of Willson does not teach, suggest, or disclose the method recited in amended independent claims 1 and 19 of the present application. Willson describes a rather narrow method in which a multicell holder is treated with "solutions/suspensions of catalyst ingredients to produce cells, spots, or pellets holding each of a variety of combinations of the [catalyst] ingredients, is...treated as necessary to stabilize the [catalyst] ingredients...then is contacted with a potentially reactive feed stream or batch...." Abstract; col. 2, lines 44-55. This described method thus contemplates merely those situations in which all of the catalysts being tested are disposed and stabilized on the holder prior to exposing any catalyst to any reactant, then exposing the entire catalyst-laden holder to a common stream or batch of reactant. In stark contrast, amended claims 1 and 19 recite methods in which the exposure of catalysts to reactants is achieved sequentially, such that the delivery of one catalyst and selected reactants to one region of the substrate occurs before delivery of a different catalyst and reactants to another region of the substrate. Such an arrangement is patentably distinct from the applied references, because it is not physically possible to achieve in the method described in Willson. The advantage of the method recited in present claims 1 and 19 over

that described in Willson is that the present method allows for more flexibility in the manner in which reactants and catalysts are disposed and reacted.

The requirement by Willson that all catalysts be applied and stabilized on the substrate prior to exposure to reactants is quite limiting, and several of the instant claims dependent from claim 1 illustrate additional details of the method that are clearly not taught, suggested or disclosed by this applied reference. For example, the description in Willson that catalysts are applied and stabilized on the substrate prior to reactant exposure teaches away from embodiments recited in instant claims 9 and 27 (where the delivery of first catalyst and reactants to the first region on the substrate occurs before the delivery of second catalyst and reactants to a second region on the substrate); claims 11, 16, 29, and 34 (where at least one of the reactants is delivered to the substrate before the catalyst is delivered); and claims 14, 15, 32, and 33 (where at least one reactant is mixed with the catalyst prior to its delivery to the substrate).

The combination of Sakashita with Willson does not overcome the shortcomings of the latter. Sakashita merely describes the various possibilities of catalyst and reactant species used in the formation of polycarbonate. There is nothing in this reference that would suggest altering Willson to achieve the sequential process recited in claim 1 or in claim 19 of the present application, or the more specific embodiments that recite mixing a reactant with catalysts prior to application to the substrate or by disposing the reactants on the substrate prior to delivery of the catalysts. Even if somehow Sakashita could be construed to provide such a suggestion, to attempt to implement such a suggestion would render Willson's method inoperable, because in Willson the catalysts are affixed and stabilized on the substrate to enable exposure to a common stream of reactant. The methods recited in the instant claims are not physically achievable using the method of Willson, with or without the additional disclosure of Sakashita. Therefore, Applicants respectfully submit that a *prima facie* case of obviousness cannot be made against the instant claims by this combination of references.

For the reasons described above, Applicants respectfully submit that independent claims 1 and 19, and their respective pending dependent claims, are patentably distinct from

the combination of Willson and Sakashita. Favorable reconsideration is respectfully requested.

2. Double Patenting

Applicants respectfully request that the obviousness-type double patenting rejection of claims 1-35 and 38-45 be held in abeyance until such time as allowability of the application with respect to the above 35 U.S.C. 103 (c) rejection has been determined, in order to better determine the exact scope of the instant claims. At such time the issue of filing a terminal disclaimer will be reconsidered.

3. Conclusion

Applicants believe this to be a full and complete response to the referenced Office Action, and respectfully request favorable reconsideration. If, however, any issues remain unresolved, the Examiner is invited to telephone the undersigned at the number provided below.

Respectfully submitted,



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